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09/754,897	01/05/2001	Salvatore J. Stolfo	10199-006	4766

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NEW YORK, NY 10017

EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/754,897

Applicant(s)

STOLFO ET AL. 

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Claims 1-27 have been examined.

#### *Priority*

2. Applicant's claim for priority to United States Provisional Patent Application serial No. 60/174,638 filed on 5 January 2000 is acknowledged.

#### *Claim Objections*

1. Claim 10 is objected to because of the following informalities: examiner believes that instead of the "a shipper..." should be the shipper..."
2. Claim 6 is objected to because of the following informalities: examiner believes that instead of the "generated for each transaction by the user" it should be "generated for each transaction for the user". It is not clear that user is able to generate such proxy name except to request such transaction. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 1-19 and 25-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." In re Musgrave, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See AT&T v. Excel Communications Inc., 172 F.3d at 1358, 50 USPQ2dat 1452.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1, 19, 20, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: there is no step of who or how the decryption information is provided to the shipper. It is not clear that the user, merchant or the third party provide the shipper with the decryption information.

8. Claim 20 has the communications link with the capability of transmitting the proxy identity and partially encrypted shipping address, however, there is no actual reception of or transmission of such data by the merchant.

9. Claim 25 has a recitation of "Address Verification String", it is not clear if the merchant generates the string or the third party generates and forwards the string to the merchant.

10. Dependent claims 2-18, 21-24, and 26-27 are unclear in that they depend from unclear independent claims.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 1-2, 6-7, 9-11, 13, 16-18, 20-21, and 24-27 are rejected under 35 U.S.C. 102(a) as being anticipated by Jeffrey M. Zucker et al. International Publication No. WO 99/66428.

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13. As per claims 1, 20, and 25, Zucker clearly teaches a method and system providing private shipping of items to users purchasing goods on a computer-based communications network comprising the steps of:

- providing a proxy identity ( pseudo identity, pseudo name, or buyer ID) to a user (buyer)(See Zucker figure 12, page 9, lines 1-9);
- receiving a shipping address for the user (See Zucker figure 12, page 8, lines 18-28);
- partially encrypting the user's shipping address (See Zucker figure 13, page 10, lines 15-24 and page 23, lines 20-page 24, line 8);
- transmitting the proxy identity and encrypted shipping address to a merchant (seller) (See Zucker page 10, lines 15-24 and page 23, lines 20-page 24, line 8); and
- providing decryption information to a shipper (See Zucker page 10, lines 15-24 and page 23, lines 20-page 24, line 8);
- whereby upon receipt of the encrypted shipping address from the merchant, the shipper can use the decryption information to decrypt the address and generate a package label bearing the true shipping address of the user so that the merchant is prevented from electronically capturing the true identity of the user (See Zucker page 10, lines 15-24 and page 23, lines 20-page 24, line 8).

14. As per claims 2 and 26, Zucker teaches all the limitations of claims 1 and 25, further;  
Zucker teaches the proxy identity comprises a proxy name and a proxy credit card account number (See Zucker page 10, lines 15-24).

15. As per claim 6, Zucker teaches all the limitations of claim 2, further;  
Zucker teaches a new proxy name (single-use buyer IDs) is generated for each transaction by the user (See Zucker page 9, lines 10-20).

16. As per claims 7 and 27, Zucker teaches all the limitations of claims 1 and 25, further;

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Zucker teaches the communications network is the Internet (See Zucker page 4, lines 16-18, and page 6, lines 20-22).

17. As per claims 9, Zucker teaches all the limitations of claim 1, further;

Zucker teaches the encrypted shipping address contains sufficient information (actual city, state and zipcode) to allow the merchant to calculate an appropriate transaction tax (See Zucker page 10, lines 15-24).

18. As per claim 10, Zucker teaches all the limitations of claim 1, further comprising:

maintaining a secure database of user transaction information; and providing access to the database to a shipper to resolve a shipping problem (pseudo payment information) (See Zucker page 24, lines 1-11).

19. As per claim 11, Zucker teaches all the limitations of claim 10, further;

Zucker teaches the transaction information includes instructions for returning undeliverable items (See Zucker page 15, line 18-page 17, line 15).

20. As per claims 13 and 21, Zucker teaches all the limitations of claims 1 and 20, further comprising generating a unique shopping session identification number (reference number) (See Zucker figure 13, page 11, lines 19-22 and page 13, lines 5-23).

21. As per claims 16 and 24, Zucker teaches all the limitations of claims 1 and 20, further;

Zucker teaches the encrypted shipping address includes an index number (reference number) for cross-reference to a database of real shipping addresses (See Zucker page 14, lines 10-16).

22. As per claim 17, Zucker teaches all the limitations of claim 1, further comprising randomly inserting at least one atypical textual character into the true shipping address before encrypting the shipping address (See Zucker page 10, lines 15-20, where buyer ID corresponds to one atypical textual character added to the shipping address and buyer ID is random as recited in line 19).

23. As per claim 18, Zucker teaches all the limitations of claim 1, further comprising:

receiving a privacy level selection (Privacy preference) from the user for a shipment; and selecting an encryption algorithm for the user's shipping address based upon the selected privacy level (See Zucker page 8, lines 19-28).

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24. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 12, 14-15, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 99/66428 to Jeffrey M. Zucker et al.

27. As per claim 12, Zucker teaches all the limitations of claim 1, further;

What Zucker is not explicit on teaching the user's encrypted shipping address contains an identifier that may be used as an electronic mail address to contact the user (See Zucker page 8, lines 19-28).

However, Zucker clearly teaches the availability of such identifier (email address) to be forwarded along with the physical address to a shipper or any other entity for contact purposes. It would also be clear to preserve the privacy the email address would be encrypted along with the actual address.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to encrypt the email address along with the physical address for the motivation of preserving the privacy and preventing merchants from accessing such information.

28. As per claims 14-15 and 22-23, Zucker teaches all the limitations of claims 1, 13 and 20, 21, further;

Zucker teaches the encrypting of the shipping address.

Zucker is not explicit on that the encrypting of the address is a function of the shopping session identification number (reference number) or a function of time (See Zuker page 10, lines 19-20 and page 14, lines 10-16, and page 23, lines 21-page 24, line 11).

However, the above method of encryption, as to use a session ID as a functional of the encrypted data for further ensuring of the authenticity and integrity of the content of the encrypted data is well recognized. Also, time stamping or encryption based on a function of time is an essential part of encryption methods recognized in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to include the encryption of the shipping address as function of the session ID (reference number) as well as time for the motivation of further control over the data integrity as well as superior encryption of the data.

29. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 99/66428 to Jeffrey M. Zucker et al. in view of U.S. Patent No. 5,903,652 to Amit Mital.

30. As per claim 19, Zucker clearly teaches a method for providing private shipping of items to users purchasing goods on a computer-based communications network comprising the steps of:

- providing a proxy identity to a user, receiving a shipping address for the user; partially encrypting the user's shipping address;



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- transmitting the proxy identity and encrypted shipping address to a merchant; whereby upon receipt of the encrypted shipping address from the merchant, the shipper can generate a package label bearing the partially encrypted mailing address of the user with the post office box number so that the merchant is prevented from electronically capturing the true identity of the user.

What Zucker is not explicit on is the appending a post office box number to the user's encrypted shipping address.

However, Mital clearly teaches that additional shipping information (P.O.Box number) maybe added by other entities (Third party system). It is also a recognized practice in the industry to substitute an actual address with a P. O .Box number as drop ship location for protection of privacy, examples are postal locations, Western Union offices, or Mail Box Etc. locations.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to add additional information such as a P.O.Box number to an obfuscated address for the motivation of further protecting the privacy of a user of the system.

31. Claims 3-5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 99/66428 to Jeffrey M. Zucker et al. in view of U.S. Patent Application Publication No. 2001/0011247 A1 to Kenneth W. O'Flaherty.

32. As per claim 3, Zucker teaches all the limitations of claim2, further;

Zucker does not explicitly teach the step of issuing a proxy identity includes issuing a physical integrated circuit card to the user.

However, O'Flaherty clearly teaches the issuing of "Privacy Card" (See O'Flaherty figure 5, page 7, [0093]-[0095]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Zucker and O'Flaherty to issue a smart card that

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is containing the information regarding the privacy information of the user for the motivation of portability as well as versatility of control access via the smart card in use along with data warehouses.

33. As per claim 4, Zucker teaches all the limitations of claim 3, further comprising the step of authenticating (matching buyer ID with a password) the user's proxy identity (See Zucker page 8, lines 19-28).

34. As per claim 5, Zucker teaches all the limitations of claim 4, further;  
Zucker clearly teaches the step of authenticating the proxy identity.

What Zucker is not explicit about is authentication includes reading the integrated circuit card via a card reader.

However, O'Flaherty clearly teaches that such process of card reader authenticate such proxy identity (unique customer identification)(See O'Flaherty page 8, [0098], [0102]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the authentication method of the Zucker with that of O'Flaherty for the motivation of better protection against un-authorized use of a portable device containing personal and privacy information.

35. As per claim 8, Zucker teaches all the limitations of claim 1, further;  
Zucker teaches the user's proxy identity is available to a user.

What is not explicitly taught by Zucker is such proxy identity is stored in a digital wallet.

However, O'Flaherty clearly teaches that such proxy is stored in a smart card (electronic wallet)(See O'Flaherty page 7, [0093]-[0095] and page 8, [0098], [0102])

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to take advantage of the teachings of O'Flaherty in combination with teachings of Zucker as to store information in a digital wallet for the motivation of the security, portability as well as access control of the user over the information in such digital container be it virtual or actual.

36. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of

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the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

**Conclusion**

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9 AM to 5:00 PM.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

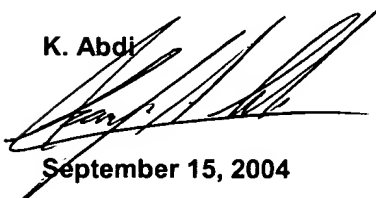
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Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive  
7th floor receptionist, Arlington, VA, 22202**

K. Abdi



September 15, 2004